

REMARKS

Claims 5-8 stand rejected under 35 U.S.C. § 102 as being anticipated by Garrett '873 ("Garrett"). Claims 5 and 7 are independent. This rejection is respectfully traversed for the following reasons.

Claim 5 recites in pertinent part, "an information processing apparatus identifier production device that produces an identifier for *the information processing apparatus based on* an identifier of a network card" (emphasis added). Claim 7 recites a similar feature in method format.

The Examiner relies on the "unique preset time duration or time constant designated for each *expansion device*" of Garrett as the produced "identifier" recited in the pending claims. However, as acknowledged by the Examiner, the disclosed expansion devices of Garrett relate to removable adapter cards coupled to the alleged information processing apparatus. That is, according to the Examiner, at best, Garrett merely discloses producing identifiers *for the alleged network cards*. Garrett does not disclose or suggest producing an identifier *for the alleged information processing apparatus as a whole*, let alone produce such an identifier *based on* an identifier of a network card.

Indeed, Garrett appears silent as to any external interaction of the alleged information processing apparatus with a network, thereby rendering disclosure of an identifier therefor unnecessary. Garrett, on the other hand, uses a host computer 102 to identify option modules/ expansion devices which are coupled to an expansion bus. As previously mentioned, Garrett merely describes a method by which the identifier of the expansion devices are identified by the host computer using an identification signal. Regardless of the identification process, each of the expansion devices in Garrett has a *pre-existing identifier*.

The Examiner has equated the pre-existing identifier of the expansion device as “producing an identifier.” It may be true that the pre-existing identifiers were inherently at some point produced. However, the pre-existing identifiers of Garrett were NOT produced based on an identifier of another network card, let alone in relation to the demountability thereof. Instead, an identifier was programmed into the logic circuitry of a given expansion device *independently* of any characteristic of the other expansion devices. In sum, even assuming *arguendo* that the alleged network cards of Garrett have “demountability” characteristics and identifiers, Garrett does NOT suggest using the identifier of one card to produce the identifier of another card based on a demountability characteristic of the one card. Moreover, as discussed above, Garrett at best is related only to identifiers of the network cards rather than the alleged information processing apparatus.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that “inherency may not be established by probabilities or possibilities”, *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int’l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Garrett does not anticipate claims 5 and 7, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 5 and 7 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also

patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is respectfully submitted that claims 5-8 are patentable over Garrett. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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